

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

NAKAI et al.

Application No.: **09/897,988**

Filing Date: July 5, 2001

For: METHOD FOR PRODUCING
SUBSTANCE UTILIZING
MICROORGANISM

Art Unit: 1633

Examiner: Maria Marvich

Attorney Ref. No.: US-1420

Confirmation No.: 1677

REPLY BRIEF FOR APPELLANT

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

COMES NOW the Appellant to present this Reply Brief in compliance with 37 C.F.R. §41.41. This Reply Brief is in response to the Examiner's Answer mailed April 6, 2007. A petition for an extension of time is not necessary, as this reply brief is filed with 2 months of the mailing date of the Examiner's Answer.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. If, however, additional extensions of time are necessary to prevent abandonment of this application or dismissal of this appeal, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is hereby authorized to charge fees necessitated by this paper, and to credit all refunds and overpayments, to Deposit Account 50-2821.

For the following reasons, Appellant respectfully submits that the final rejection of each of Claims 1, 7, and 12-14 in this application continues to be in error, and therefore respectfully requests reversal of the rejections.

In the Examiner's Answer dated April 6, 2007, beginning at page 4, the rejections under 35 U.S.C. §102 by Ciccognanu et al. or Spehr et al. is maintained on the grounds that the disclosed strain of cells inherently produce amino acids, and the cells are collected, so hence the step of collecting the cells from the medium would lead to the collection of target substances. However, as described in "Field of the Invention" of the specification, an object of the present invention is to improve the production of a target substance using a microorganism. Both Ciccognani et al. and Spehr et al. do not even address the production of target substances, and are therefore, irrelevant to the production of target substances. Finally, neither of these references discloses a step of collecting L-amino acids and nucleic acids, and therefore, do not satisfy the "four corners" doctrine, in that not every limitation of the claims is recited in the single prior art reference. *Advanced Display Systems, Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). For this reason alone, these rejections must be withdrawn.

In the Examiner's Answer, it is also stated that the interpretation of the phrase "the ability to produce and accumulate the target substance" as set forth in the Appeal Brief is "reading limitations into the claims that are not found in either the claims or the specification" (see page 5 of the Examiner's Answer). To the contrary, this phrase or variations of this phrase, are present in the specification (see, for example page 4, 3rd full paragraph, page 5, 8th full paragraph, etc.). Furthermore, since the present invention relates to a production method of a target substance using a microorganism as is set forth throughout the specification, one of ordinary skill in the art would reasonably construe this phrase within the meaning of the specification to mean the ability to produce L-amino acids and nucleic acid in an amount more than the amount required for growth of the bacterium. Neither Ciccognani et al. nor Spehr et al. disclose such kind of strain.

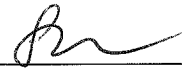
For at least the reasons presented herein, each of the subject matters of Claims 1, 7, and 12-14, taken as a whole, are patentable and are not anticipated by Ciccognani et al. or Spehr et al. under 35 U.S.C. § 102. Accordingly, the rejection of each of Claims 1, 7, and 12-14 under 35 U.S.C. § 102 is in error.

IX. Conclusion

For at least the foregoing reasons, Appellant respectfully submits that the subject matters of Claims 1, 7, and 12-14, each taken as a whole, are patentable. Accordingly, Appellant respectfully requests reversal of the rejections of Claims 1, 7, and 12-14 under 35 U.S.C. § 102(a).

Respectfully submitted,

By: _____



Shelly Guest Cermak
Registration No. 39,571

U.S. P.T.O. Customer Number 38108

Cermak & Kenealy LLP
515 East Braddock Road, Ste. B
Alexandria, VA 22314
703 778 6608
703 652 5101 (fax)

Date: June 5, 2007